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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/809,889	03/26/2004	Yoshifumi Tanimoto	042089	7798

38834 7590 11/02/2007
WESTERMAN, HATTORI, DANIELS & ADRIAN, LLP
1250 CONNECTICUT AVENUE, NW
SUITE 700
WASHINGTON, DC 20036

EXAMINER

SAMS, MATTHEW C

ART UNIT	PAPER NUMBER
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2617

MAIL DATE	DELIVERY MODE
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11/02/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Interview Summary	Application No.	Applicant(s)	
	10/809,889	TANIMOTO, YOSHIFUMI	
	Examiner	Art Unit	
	Matthew C. Sams	2617	

All participants (applicant, applicant's representative, PTO personnel):

(1) Matthew C. Sams. (3)_____.

(2) Thomas E. Brown (Reg. 44,450). (4)_____.

Date of Interview: 17 October 2007.

Type: a) ☒ Telephonic b) ☐ Video Conference
c) ☐ Personal [copy given to: 1) ☐ applicant 2) ☐ applicant's representative]

Exhibit shown or demonstration conducted: d) ☐ Yes e) ☒ No.
If Yes, brief description: _____.

Claim(s) discussed: 1, 7 and 13.

Identification of prior art discussed: Dorenbosch (US 2002/0173308).

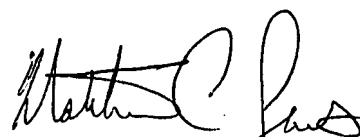
Agreement with respect to the claims f) ☒ was reached. g) ☐ was not reached. h) ☐ N/A.

Substance of Interview including description of the general nature of what was agreed to if an agreement was reached, or any other comments: See Continuation Sheet.

(A fuller description, if necessary, and a copy of the amendments which the examiner agreed would render the claims allowable, if available, must be attached. Also, where no copy of the amendments that would render the claims allowable is available, a summary thereof must be attached.)

THE FORMAL WRITTEN REPLY TO THE LAST OFFICE ACTION MUST INCLUDE THE SUBSTANCE OF THE INTERVIEW. (See MPEP Section 713.04). If a reply to the last Office action has already been filed, APPLICANT IS GIVEN A NON-EXTENDABLE PERIOD OF THE LONGER OF ONE MONTH OR THIRTY DAYS FROM THIS INTERVIEW DATE, OR THE MAILING DATE OF THIS INTERVIEW SUMMARY FORM, WHICHEVER IS LATER, TO FILE A STATEMENT OF THE SUBSTANCE OF THE INTERVIEW. See Summary of Record of Interview requirements on reverse side or on attached sheet.

Examiner Note: You must sign this form unless it is an Attachment to a signed Office action.



 Examiner's signature, if required

Summary of Record of Interview Requirements

Manual of Patent Examining Procedure (MPEP), Section 713.04, Substance of Interview Must be Made of Record

A complete written statement as to the substance of any face-to-face, video conference, or telephone interview with regard to an application must be made of record in the application whether or not an agreement with the examiner was reached at the interview.

Title 37 Code of Federal Regulations (CFR) § 1.133 Interviews

Paragraph (b)

In every instance where reconsideration is requested in view of an interview with an examiner, a complete written statement of the reasons presented at the interview as warranting favorable action must be filed by the applicant. An interview does not remove the necessity for reply to Office action as specified in §§ 1.111, 1.135. (35 U.S.C. 132)

37 CFR §1.2 Business to be transacted in writing.

All business with the Patent or Trademark Office should be transacted in writing. The personal attendance of applicants or their attorneys or agents at the Patent and Trademark Office is unnecessary. The action of the Patent and Trademark Office will be based exclusively on the written record in the Office. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt.

The action of the Patent and Trademark Office cannot be based exclusively on the written record in the Office if that record is itself incomplete through the failure to record the substance of interviews.

It is the responsibility of the applicant or the attorney or agent to make the substance of an interview of record in the application file, unless the examiner indicates he or she will do so. It is the examiner's responsibility to see that such a record is made and to correct material inaccuracies which bear directly on the question of patentability.

Examiners must complete an Interview Summary Form for each interview held where a matter of substance has been discussed during the interview by checking the appropriate boxes and filling in the blanks. Discussions regarding only procedural matters, directed solely to restriction requirements for which interview recordation is otherwise provided for in Section 812.01 of the Manual of Patent Examining Procedure, or pointing out typographical errors or unreadable script in Office actions or the like, are excluded from the interview recordation procedures below. Where the substance of an interview is completely recorded in an Examiners Amendment, no separate Interview Summary Record is required.

The Interview Summary Form shall be given an appropriate Paper No., placed in the right hand portion of the file, and listed on the "Contents" section of the file wrapper. In a personal interview, a duplicate of the Form is given to the applicant (or attorney or agent) at the conclusion of the interview. In the case of a telephone or video-conference interview, the copy is mailed to the applicant's correspondence address either with or prior to the next official communication. If additional correspondence from the examiner is not likely before an allowance or if other circumstances dictate, the Form should be mailed promptly after the interview rather than with the next official communication.

The Form provides for recordation of the following information:

- Application Number (Series Code and Serial Number)
- Name of applicant
- Name of examiner
- Date of interview
- Type of interview (telephonic, video-conference, or personal)
- Name of participant(s) (applicant, attorney or agent, examiner, other PTO personnel, etc.)
- An indication whether or not an exhibit was shown or a demonstration conducted
- An identification of the specific prior art discussed
- An indication whether an agreement was reached and if so, a description of the general nature of the agreement (may be by attachment of a copy of amendments or claims agreed as being allowable). Note: Agreement as to allowability is tentative and does not restrict further action by the examiner to the contrary.
- The signature of the examiner who conducted the interview (if Form is not an attachment to a signed Office action)

It is desirable that the examiner orally remind the applicant of his or her obligation to record the substance of the interview of each case. It should be noted, however, that the Interview Summary Form will not normally be considered a complete and proper recordation of the interview unless it includes, or is supplemented by the applicant or the examiner to include, all of the applicable items required below concerning the substance of the interview.

A complete and proper recordation of the substance of any interview should include at least the following applicable items:

- 1) A brief description of the nature of any exhibit shown or any demonstration conducted,
- 2) an identification of the claims discussed,
- 3) an identification of the specific prior art discussed,
- 4) an identification of the principal proposed amendments of a substantive nature discussed, unless these are already described on the Interview Summary Form completed by the Examiner,
- 5) a brief identification of the general thrust of the principal arguments presented to the examiner,
(The identification of arguments need not be lengthy or elaborate. A verbatim or highly detailed description of the arguments is not required. The identification of the arguments is sufficient if the general nature or thrust of the principal arguments made to the examiner can be understood in the context of the application file. Of course, the applicant may desire to emphasize and fully describe those arguments which he or she feels were or might be persuasive to the examiner.)
- 6) a general indication of any other pertinent matters discussed, and
- 7) if appropriate, the general results or outcome of the interview unless already described in the Interview Summary Form completed by the examiner.

Examiners are expected to carefully review the applicant's record of the substance of an interview. If the record is not complete and accurate, the examiner will give the applicant an extendable one month time period to correct the record.

Examiner to Check for Accuracy

If the claims are allowable for other reasons of record, the examiner should send a letter setting forth the examiner's version of the statement attributed to him or her. If the record is complete and accurate, the examiner should place the indication, "Interview Record OK" on the paper recording the substance of the interview along with the date and the examiner's initials.

Continuation of Substance of Interview including description of the general nature of what was agreed to if an agreement was reached, or any other comments: The examiner maintains the rejection to claims 1 and 7, but sees a potential distinction between claim 13 and Dorenbosch. The potential distinction is whether a user previously logged into a proxy, but not currently in communication with the proxy is viewed as "not logged in the instant message server". Under consideration would be the ability to implement the functions of the IM Proxy in the same server that functions as the IM messaging or Login server. Alone, Dorenbosch might not meet the limitation, however Li et al. (US 2003/018248 Fig. 3 [348], Page 7 [0090] and Page 8 [0105]), Malik et al. (US 2005/0044144 Pages 2-3 [0020]) and Caplan (US-2003/0050834 Page 4 [0036]) each teaches the ability to transmit and store/buffer messages to a user that is offline. Further search/consideration is needed pending the applicant's submission of an amendment.

**FACSIMILE**

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Date: October 17, 2007

To: Examiner Matthew Sams
Group Art Unit: 2617
U. S. Patent and Trademark Office

Re: U.S. Patent Application No. 10/809,889
By: TANIMOTO et al.
Title: COMMUNICATION DEVICE AND
COMMUNICATION METHOD
Our Reference: 042089

Fax Number: (571) 273-8099

Number of Pages: 4 (including cover sheet)

From: Thomas E. Brown/nrp

PLEASE ACKNOWLEDGE SAFE AND CLEAR RECEIPT OF ALL PAGES BEING SENT

DATE OF INTERVIEW: 10/17/07

TIME: 2:30 p.m.

Attached is the Agenda for Interview

Thomas E. Brown

THE INFORMATION CONTAINED IN THIS MESSAGE IS CONFIDENTIAL INFORMATION INTENDED ONLY FOR THE USE OF THE INDIVIDUAL OR ENTITY TO WHICH IT IS ADDRESSED. This message may also be an attorney/client communication that is privileged and confidential. If the reader of this message is not the intended recipient, or the employee or agent responsible to deliver it to the intended recipient, you are hereby notified that any distribution or copying of this communication is strictly prohibited. If you have received this communication in error, please notify us immediately by calling us collect and return the original message to us at the above address by mail. Thank you.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of: **Yoshifumi TANIMOTO**

Group Art Unit: **2617**

Application Number: **10/809,889**

Examiner: **Matthew C. Sams**

Filed: **March 26, 2004**

Confirmation Number: **7798**

For: **COMMUNICATION DEVICE AND COMMUNICATION
METHOD**

Attorney Docket Number: **042089**
Customer Number: **38834**

AGENDA FOR INTERVIEW

Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

October 17, 2007

Sir:

Applicant gratefully appreciates the Examiner granted telephone interview with regard to the above-identified application.

During such interview, Applicant's representative, Thomas Brown, wishes to discuss the following:

In the Advisory Action dated August 22, 2007, it is noted that the Examiner relies on the disclosure of Fig. 7, paragraph [0033] of Dorenbosch for teaching the features of claim 1 concerning transmitting an instant message including identification information of the terminal of the forwarding destination from the terminal of the forwarder to a communication device when the user of the forwarding information is not logged in the instant message server. More specifically, the Examiner asserts that when the subscriber 14 sends an instant message to the subscriber 12, as shown in Fig. 7, the instant message must first be addressed and sent to the IM server 20; after which the instant message is then forwarded to the IM proxy 24'. The Examiner further asserts that since the IM proxy 24' registers with the IM server 16 on behalf of the mobile subscriber 12 and is able to recognize the subscriber 12 based on the information contained in the subheader 48, it is obvious that Dorenbosch teaches the target buddy subheader 48 includes forwarding destination information.

However, the Examiner fails to appreciate that claim 1 calls for "*wherein when the user of the forwarding destination logs in, the forwarding destination information ... is extracted.*" In Dorenbosch, the subscriber 12 is already logged into the IM server 16, when the IM proxy 24' receives the instant message 96 from the IM server 20. The Examiner has failed to appreciate that in the preceding paragraph [0032], Dorenbosch clearly discloses that the mobile subscriber 12 and conventional subscriber 14 register with the IM server 16. Moreover, as clearly shown in Fig. 7, the subscriber 12 first sends the instant message 90 to the IM server 20, and therefore must be logged in before the instant message 96 is received by the IM proxy 24'.

In addition, with regard to independent claim 13, and Applicant's argument that Dorenbosch teaches that the information is only transmitted to the IM proxy when the mobile subscriber 12, or forwarding destination, is logged onto the IM system 10, the Examiner fails to provide a persuasion response. Instead, the Examiner relies on the disclosure in paragraph [0033] regarding the IM proxy 24' registers with the IM server 16 on behalf of the mobile subscriber 12. However, the Examiner has failed to appreciate that in the preceding paragraph [0032], Dorenbosch clearly discloses that the mobile subscriber 12 and conventional subscriber 14 register with the IM server 16. In other words, in Fig. 7 of Dorenbosch, before the IM proxy 24' receives and stores the instant message 96, the mobile subscriber 12 and the conventional subscriber 14 have already registered with the IM server 16.

Respectfully submitted,

WESTERMAN, HATTORI, DANIELS & ADRIAN, LLP

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TEB/nrp